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31 JUL 2007

KED & ASSOCIATES, LLP
P.O. BOX 221200
CHANTILLY, VA 20153-1200

In re Application of
OGILVY, Ian Charles : DECISION ON
Application No.: 10/585,134 :
PCT No.: PCT/AU01/00435 : PETITION
Int. Filing Date: 17 April 2001 :
Priority Date: 17 April 2000 : UNDER 37 CFR 1.47(b)
Attorney's Docket No.: CRD-0005 :
For: Communications Device With Card Facility :

This is a decision on applicant's "Petition Under 37 C.F.R. 1.47(b)," filed in the United States Patent and Trademark Office on 14 May 2007 on behalf of the assignee and the non-signing inventor Ian Charles Ogilvy.

BACKGROUND

On 17 April 2001, applicant filed international application PCT/AU01/00435, claiming a priority date of 17 April 2000. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 October 2002.

On 17 October 2002, at midnight, the instant application became abandoned with respect to the United States because applicant did not timely file the required materials to enter the national stage in the United States.

On 29 June 2006, applicant filed a "Petition For Revival Of Abandoned Application Under 37 CFR 1.137(b)."

On 24 July 2006, the Office granted applicant's "Petition For Revival Of Abandoned Application Under 37 CFR 1.137(b)."

On 22 February 2007, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b), the surcharge for late filing of the oath or declaration and additional claim fees were required.

On 14 May 2007, applicant submitted, *inter alia*, the declaration, the surcharge for late filing of the declaration, a one-month extension fee, the additional claim fees, a declaration of relevant facts by Mr. Andrew Smyth, a statement under 37 CFR 3.73(b) and the present petition filed under 37 CFR 1.47(b) requesting acceptance of the application without the signature of the applicant.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

With regard to item (1), applicant has not provided the requisite fee of \$200 under 37 C.F.R. 1.17(g). Hence, item (1) has not been satisfied.

With regard to item (2), the declaration of Mr. Andrew Smyth is not clear as to whether Mr. Andrew Smyth has “firsthand knowledge” of the facts recited, because the declaration refers on multiple occasions to “we.” Specifically, “[w]e had heard...we heard...we have written...we had resorted.” (See MPEP §409.03(d): “Statements based on hearsay will not normally be accepted.”). Furthermore, although the declaration indicates that rumors existed as to whereabouts of the non-signing inventor, the declaration does not indicate the steps taken by Mr. Andrew Smyth to locate the whereabouts of the non-signing inventor. Copies of documentary evidence such as, a certified mail return receipt, cover letter of instructions, telegrams, Internet searches, telephone searches, which support a finding that the non-signing inventor cannot be reached after a diligent effort, should be made a part of the declaration. Hence, item (2) has not been satisfied.

With regard to item (3), the last known address of non-signing inventor Ian Charles Ogilvy is indicated as: Suite 306, 39 East Esplanade, Manly, New South Wales, Australia, 2095. Hence, item (3) has been satisfied.

With regard to items (4) and (5), the declaration executed by the 37 CFR 1.47(b) applicant does not comply with 37 C.F.R. 1.497(a)-(b) because the declaration has not been executed in accordance with 37 CFR §§1.497(b)(1) and 1.47(b):

The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

...a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors.

Specifically, the assignment from non-signing inventor Ian Charles Ogilvy to CardSoft International PTY Limited, as represented by the "Deed of Assignment" ("Deed"), does not satisfy the requirements of 37 C.F.R. 1.47(b). The Deed is drawn only to the patent applications mentioned in Schedule 1 ("Patents"). A review of Schedule 1 does not show that the instant application or the priority application upon which it is based have been included. Furthermore, the assignment from CardSoft International PTY Limited to CardSoft, Inc. does not include a reel and frame number as required under 37 CFR 3.73(b). Therefore, the evidence provided is not sufficient to prove that the instant application has been assigned to the 37 CFR 1.47(b) applicant. Furthermore, petitioner has not provided a statement by a person having firsthand knowledge showing that that the invention was made by the employee while employed by the 37 C.F.R. 1.47(b) applicant. See MPEP §409.03(f). Hence, items (4) and (5) have not been satisfied.

With regard to item (6), petitioner has demonstrated that irreparable harm will result if the application is not permitted to proceed. Hence, item (6) has been satisfied.

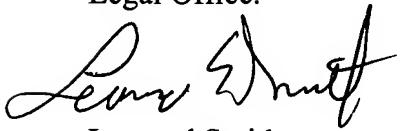
Based on the totality of the evidence currently of record, it would not be appropriate to consider the requirements of 37 CFR 1.47(b) to have been satisfied.

CONCLUSION

Applicant's petition requesting acceptance of the application without the signature of the inventor is DISMISSED, without prejudice, for the reasons described *supra*.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3297
Facsimile: (571) 273-0459



Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208

CC: DUANE MORRIS LLP
1667 K STREET, N.W.
SUITE 700
WASHINGTON, D.C. 20006